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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,387	02/06/2004	Chun-Ching Liao	3074/142	5748

7590

05/27/2004

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EXAMINER

WALCZAK, DAVID J

ART UNIT

PAPER NUMBER

3751

DATE MAILED: 05/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/772,387	Applicant(s) LIAO, CHUN-CHING	
	Examiner David J. Walczak	Art Unit 3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

The disclosure is objected to because of the following informalities: O page 2, line 21 "nib hole (113) should be --nib hole (112)--. Appropriate correction is required.

### ***Claim Objections***

Claim 1 is objected to because of the following informalities: On line 16m "distal" should be deleted, on line 19, "receiving" should be --received—and on line 22, "proximal" should be --front--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Korper in view of Dufilho. Korper discloses a "white board marker" comprised of a cover 11 having front and rear ends, ribs on the side surface (the cover 11 is shown as having three annular ribs thereon), a front cavity and a rib hole, a nib having a tip extending through the nib hole and an integral refill end, a body 10 having front and rear ends and a rear cavity, an ink pad 12 abutting the refill end and received in the front and rear

cavities of the cover and body and a cap 113 having a central cavity for covering the nib. Although the Korper reference does not disclose a magnet chamber at the rear end of the body with a magnet therein, attention is directed to the Dufilho reference, which discloses another marking device wherein a magnet chamber 26 having a magnet 16 therein is mounted at the end of the body in order to enable a user to employ the writing device as a compass. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form such a chamber having a magnet therein onto the rear of the body of the Korper device in order to enable a user to employ the device as a compass.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Korper in view of Dufilho as applied to claim 1 above, and further in view of Toyama. Although the cap in the Korper reference does not include air passages therethrough, attention is directed to the Toyama reference, which discloses another pen cap wherein air passages 4 extend therethrough in order to provide an air passageway should a user swallow the cap (column 3, lines 44-53). Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide such air passageways into the cap of the Korper reference in order to provide an air passageway should the cap be swallowed.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Korper in view of Dufilho as applied to claim 1 above, and further in view of Shih. Although the marker in the Korper reference is not shaped as a bowling pin, attention is directed to the Shih reference, which discloses another marker wherein the body and cap are

shaped like a bowling pin in order to provide the marker with an amusing appearance. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to shape the Korper marker in such a fashion in order to give the marker a pleasing appearance.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Ohashi et al. reference is cited for disclosing another marker having a magnet therein.

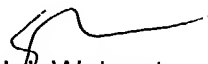
Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Walczak whose telephone number is 703-308-0608. The examiner can normally be reached on Mon-Thurs, 6:30- 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg L. Huson can be reached on 703-308-2580. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Art Unit: 3751

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David J. Walczak  
Primary Examiner  
Art Unit 3751

DJW  
5/26/04